

## **REMARKS**

Paragraph [0061] of the specification has been amended. Claims 1-9, 11-18, 20-28, 30-37, 39-47, and 49-56 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Objection to the specification:**

The Office Action objected to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter of “computer-accessible storage medium.” Office Action at 3. Applicant continues to traverse this objection for the reasons given in response to the previous Office Action. Nevertheless, Applicant has amended paragraph [0061] of the specification to clarify that “[c]omputer-accessible media that are capable of storing data, such as, e.g., any of the examples of physical media mentioned previously, may also be referred to as computer-accessible storage media.” Applicant notes that because media that store data are inherently “storage media,” and because the specification provides numerous examples of computer-accessible media that store data, the specification therefore inherently discloses computer-accessible storage media. Thus, this amendment to the specification merely makes explicit what is inherent in the specification, and therefore raises no question of new matter.

Applicant submits that in view of the foregoing, the specification provides proper antecedent basis for the claimed subject matter, and respectfully requests that the objection to the specification be withdrawn.

### **Double Patenting Rejection:**

The Office Action provisionally rejected claims 1, 11, 20, 30, 39 and 49 under the judicially- created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 13-15, 27-29 and 41-42 of co-pending Application No.

10/670,550 in view of Seshadri et al. (U.S. Patent 7,209,916) (hereinafter Seshadri), and over claims 1, 9-11, 19-21 and 30 of co-pending Application No. 10/670,549 in view of Seshadri. Applicant acknowledges the provisional rejection and will address it if and when it becomes non-provisional.

**Section 102(e) Rejection:**

The Office Action rejected claims 1-3, 11, 12, 14, 20-22, 30, 31, 33, 39-41, 49, 50 and 52 under 35 U.S.C. § 102(e) as allegedly being anticipated by Seshadri. Applicant respectfully traverses this rejection for at least the following reasons.

Regarding claim 1, Seshadri fails to disclose a computer-implemented method comprising receiving an instant messaging operation directed to a given user, wherein said given user is not offline, and wherein said instant messaging operation is associated with a given presence state of an instant messenger; determining a current presence state of said instant messenger in response to receiving said instant messaging operation, wherein said current presence state corresponds to said given user; and in response to determining that said given presence state matches said current presence state, processing said instant messaging operation.

In rejecting claim 1, the Examiner refers to portions of Seshadri at columns 2, 4, 5, and 12 as disclosing the various claim features of receiving an instant messaging operation direct to a given user, where the operation is associated with a given presence state of an instant messenger; determining a current presence state of the instant messenger in response to receiving the instant messaging operation, and in response to determining that the given presence state matches the current presence state, processing the instant messaging operation. Office Action at 9. Applicants respectfully disagree and note that while Seshadri makes mention of aspects of an instant messenger, Seshadri fails to disclose the specific features that claim 1 requires.

In general, Seshadri is directed to an “information agent” that is capable of “routing communications in accordance with an expression and flexibility framework.” Seshadri at col. 2, lines 7-9. A primary focus of Seshadri is to determine what a user’s “context” is and to use such context information to process communications. *Id.* at cols. 11-15. For example, Seshadri describes one example of rule-based context processing as “Don’t interrupt with an Instant Message request while presenting (context of presenting inhibits instant message requests).” *Id.* at col. 4, lines 16-18.

Seshadri illustrates the relationship between context, rules, and actions in FIG. 7. As shown there and as discussed at cols. 10-11, context data 710 is an input to rules logic 714 and influences the ultimate processing action that is taken. Seshadri’s definition of context data includes numerous sources of hardware and software information. *Id.* at col. 12, lines 18-63. In particular, context information may be gathered from the fact that “[an] IM client is being used to send and receive [IM] messages” and from “user entered IM status.” *Id.* Thus, according to Seshadri, these aspects of an IM client may form part of the input context that is taken into account when deciding how to process a communication event.

However, claim 1 specifically requires that it is the instant messaging operation itself that is processed in response to determining a recited condition. While Seshadri mentions aspects of an IM client as part of the input context of the information agent as mentioned above, Seshadri fails to disclose that instant messaging operations themselves are processed as a consequence of the input context. Seshadri devotes considerable detail to describing how electronic mail may be processed using the described context model. *Id.* at cols. 15-17. Alternatively, Seshadri describes how the context model may be employed to perform telephone call routing. *Id.* at col. 17, lines 37-64. However, Seshadri specifically omits any mention of how an instant messaging operation may be the object of processing itself, as opposed to merely an input to processing of something else.

Additionally, claim 1 requires that an instant messaging operation be associated with a given presence state of an instant messenger. Seshadri fails to disclose such an association. At most, Seshadri's mention of "user entered IM status" describes the status that is associated with the IM client itself. However, a presence state of an instant messenger is not identical to or suggestive of a presence state that is associated with an instant messaging operation. As noted in claim 1, an instant messaging operation is something that is capable of being received, and is thus distinct in kind from an IM client.

Finally, claim 1 requires that the recited instant messaging operation be processed in response to determining that the given presence state associated with the instant messaging operation matches the current presence state of an instant messenger. Seshadri's vague mention of IM status as constituting part of a broad cloud of "context information" does not amount to a disclosure of the specific recitals of claim 1. Seshadri simply fails to mention any aspect of determining whether a presence state of an instant messenger matches a presence state associated with a received instant messaging operation, much less performing any action in response to making such a determination.

Similar arguments apply to independent claims 20 and 39, which recite at least some features similar to independent claim 1. Additionally, similar arguments apply with respect to independent claim 11 and similar independent claims 30 and 49. Specifically, claim 11 recites a computer-implemented method comprising storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to an online given user; detecting a transition of a current presence state of said instant messenger to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting. As noted above, Seshadri fails to disclose instant messenger operations that are associated with particular presence states, whether such operations are received or stored. Further, as noted above, Seshadri fails to disclose any aspect of instant messaging operations being processed or otherwise performed in response to context information. Thus, Seshadri fails to disclose that it is an instant messaging operation that

is performed in response to detecting a transition of a current presence state of an instant messenger to a given presence state associated with a stored instant messaging operation.

Applicant notes that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it . . . cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIn, Inc. v. Verisign, Inc.*, Appeal 2007-1565, Slip Op. at 17-18 (Fed. Cir. October 20, 2008) (emphasis added). Applicant submits that Seshadri both fails to disclose all of the features recited in the independent claims as well as their recited arrangement. Therefore, Seshadri fails to anticipate these claims or their dependent claims.

#### **Section 103(a) Rejection:**

The Office Action rejected claims 4, 16, 23, 35, 42 and 54 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Seshadri in view of Cristofalo, et al. (U.S. Publication 2002/0152117), claims 5, 7, 8, 13, 15, 17, 24, 26, 27, 32, 34, 36, 43, 45, 46, 51, 53 and 55 as allegedly being unpatentable over Seshadri in view of Horvitz (U.S. Publication 2002/0087649), claims 6, 25 and 44 as allegedly being unpatentable over Seshadri and Horvitz in view of Beyda (U.S. Publication 2003/0229722), and claims 9, 18, 28, 37, 47 and 56 as allegedly being unpatentable over Seshadri in view of Horvitz (U.S. Publication 2008/0104517). Applicant can find no language in the remaining cited references that remedies the omissions of Seshadri discussed above, and respectfully traverse these rejections for at least the reasons given with respect to the independent claims.

In regard to all the rejections, Applicant submits that the rejections of various ones of the dependent claims are further unsupported by the cited references. However, as the rejections of the independent claims have been shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

## **CONCLUSION**

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69900/RCK.

Respectfully submitted,

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